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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,213	04/12/2001	Harukazu Fukami	001560-390	3646

7590 11/12/2003

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EXAMINER

HABTE, KAHSAI

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/12/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,213

Applicant(s)

FUKAMI ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 14-24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14-24 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6,14-24 and 26-31 are pending.

Response to Amendment

2. Applicant's amendment filed 10/23/03 in response to the previous Office Action (Paper No. 16) is acknowledged. Rejections of claims 1-6 and 13-25 under 35 U.S.C. § 112, second paragraph (Paper No. 16, paragraphs 7a-7c) have been obviated. Even though applicants overcome the prior art rejection by adding a proviso, said proviso is a new matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 14-24 and 26-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There has been added a proviso in claim 25, but there is no descriptive support in the specification for the said proviso. The proviso lacks description. Even a negative limitation requires description, *Ex Parte Grasselli*, 231 USPQ 393. Specifically, there is no description in the specification that

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links the definitions of R^1 = amino, X = chloro at 7 position, A = phenyl to that of R^2 and R^3 = hydrogen. This concept was not present in the specification originally.

Response to arguments

Applicants' arguments filed 05/30/2001 have been fully considered but they are not persuasive.

Applicants argue: "this language finds support in the application as filed" and also indicate that many of the original Examples show compounds that have A = benzene ring; R^1 = amino group; and R^2 and R^3 are not hydrogen atoms at the same time. The examiner disagrees with applicants. The issue is not whether or not original Examples show compounds that have A = benzene ring; R^1 = amino group; and R^2 and R^3 are not hydrogen atoms at the same time, but it is whether there is a descriptive support for the proviso. Applicants introduced the negative proviso to eliminate a prior art species. Applicants pointed out to 9 compounds that have A = benzene ring; R^1 = amino group; and R^2 and R^3 are not hydrogen atoms at the same time, but this does not constitute a description of this particular subgenus. The concept of linking the definition of A, R^1 to that of R^2 and R^3 is new and it was not originally present.

Applicants also argue by citing different case laws that deals with adequate disclosure requirements such as *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1578, 222 USPQ 833, 836 (Fed. Cir. 1984) and *Turbocare Division of Demag Delaval Turbomachinery Corp. v. General Electric Co.* 264 F.3d 111, 60, USPQ2d 1017 (Fed. Cir.2001) and *Vas-Cath Inc. v. Mahurkar*, 935 F. 2d 1555, 19 USPQ2d 1111 (Fed. Cir.

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1991), *In re Kaslow*, 707 F. 2d 1366, 217 USPQ 1089 (Fed. Cir. 1983) etc. In regard to the case laws that are related to adequate disclosure, the issue is not relevant here since applicants did not provide a descriptive support for the negative proviso. There is no disclosure for the negative proviso in the claims as originally filed. Applicants have attempted to overcome the lack of description by citing many case laws, but the arguments were not persuasive. None of the case laws specifically deals with a negative proviso. The examiner invites applicants to cite any case law that use a negative proviso in the claim that was not originally present. The introduction of a negative proviso to eliminate a prior art species is clearly a new matter.

The examiner directs applicant's attention to refer a section in the MPEP 2173.05 (i) which says:

"Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement."

There is no basis in the original disclosure for the definition of e.g. R^1 depending whether or not $R^2 = R^3 = H$.

It is recommended that applicants delete the negative proviso to overcome the rejection. Note that applicants can also overcome the prior art rejection by deleting substituents from R^1 , A, R^2 or R^3 .

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

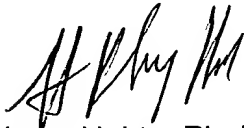
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
Art Unit 1624

KH
November 7, 2003